

**REMARKS****Response to Claim Objections**

Claim 44 is objected to by the Examiner due to the following informality in line 4, "tissue" apparently should be deleted. Claim 59 is objected to by the Examiner because of the informality in line 1, "28" apparently should read -58-. The above amendments to the claims correct these informalities.

**Response to Claim Rejections Under 35 USC §112**

Claims 58-62 are rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The examiner suggests that the term "chord length" is not defined in the present application and further that the chord length of the tissue cutting electrode is not disclosed as having a length greater than the transverse dimension of the distal end.

Applicant's have amended the claims 58 and 62 to further define the tissue cutting electrode as being "arcuate". The term "chord length" would be the length of a straight line extending between two points on the arcuate tissue cutting electrode. Figure 3 (see the attached marked up copy) clearly discloses an embodiment of the invention wherein the arcuate tissue cutting electrode has a chord length (shown in red) which is greater than the transverse dimension of the distal end. Therefore, the specification does disclose an arcuate tissue cutting member with an chord length greater than a transverse dimension of the distal end. Support can also be found in the specification on page 7, lines 24-27, which states

In the illustrated embodiment, the stylet electrode 126 is formed of an arcuate length of electrical conductor that protrudes from diametrically opposite sides of the stylet head 122, and extends over the hemispherical distal end surface of the stylet head 122.

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The Examiner also rejected claims 61 and 62 under 35 U.S.C. § 112, first paragraph, contending that the specification does not disclose a cutting member slidable disposed within a shaft. However, the feature claimed is found in Figures 12-14 and on page 8, line 26 to page 9, line 8 of the present application.

Claims 28-38, 40, 41 and 48-57 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The above amendments to the claims rejected under 35 U.S.C. §112, second paragraph, should overcome these rejections.

#### **Response to Claim Rejections Under 35 USC §102**

Claims 28, 34-36, 42, and 48 are rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by Bryan et al. (U.S. Pat. No. 5,817,034). The patent number which the Examiner refers to does not correspond with a Bryant patent. The patent number belongs to Milliman et al. Applicant assumes the Examiner refers to Bryan et al. (U.S. Pat. No. 6,050,955) or Bryant et al. (U.S. Pat. No. 6,488,636) due to the corresponding figure numbers referred to in the office action. The Bryant patents ('955 and '636) do not teach or suggest a biopsy device having an electrosurgical cutting elements on the distal end. The above amendments to the claims should overcome the rejections based on 35 U.S.C. §102(e).

Claims 58-60 are rejected under 35 U.S.C. §102(b) as being anticipated by Hofmann et al. (U.S. Pat. No. 5,925,044). Hofmann, however, does not teach or suggest a device having an elongated cutting member which is separated from a tissue cutting electrode and separately movable in relation to the tissue cutting electrode.

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Hoffmann discloses a device having electrosurgical cutting means attached to and moveable with a tube-like cutting bar. The above amendments should overcome the claims rejected under 35 U.S.C. §102(b).

#### **Response to Claim Rejections Under 35 USC §103**

Claims 29-32, 38, 40, 41, 43-46, 49-52, 54, 56 and 57 are rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Bryan et al. (U.S. Pat. No. 5,817,034) in view of Eggers et al. (U.S. Pat. No. 5,947,964). The patent number which the Examiner refers to does not correspond with a Bryant patent as mentioned above. The applicant assumes the Examiner refers to Bryan et al. (U.S. Pat. No. 6,050,955) or Bryan et al. (U.S. Pat. No. 6,488,636) which are referred to in the Examiner's Notice of references cited. The Bryant patents ('955 and '636) do not disclose, teach or suggest the use of electrosurgical cutting elements to access a biopsy site or to isolate a tissue specimen at a biopsy site. The Egger's patent discloses a biopsy and treatment device. The Egger's device has an inner needle biopsy and a pair of annular electrodes which are used for treatment (ablation). It would not have been obvious to one skilled in the art to include an electrosurgical cutter on a device having a cannula which is slidably disposed about an elongate stylet. The above amendments to the claims should overcome rejections based on 35 U.S.C. §103.

#### **Response to Allowable Subject Matter**

The applicants note with appreciation the Examiner's indication that claims 33, 37, 47 and 53 are directed to patentable subject matter. However, further amendments at this time appear unwarranted in view of the amendments made to the independent

claims from which these claims depend. The above amendments should overcome the objections and rejections.

**Conclusion**

Applicants believe the pending claims define patentable subject matter. Further consideration pursuant to the concurrently filed RCE and an early allowance of the pending claims are earnestly solicited.

Respectfully submitted,

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